

REMARKS

Claims 1-22 are pending in this application. Claims 1, 2 and 16 are independent claims.

Foreign Priority

The indication that the foreign priority documents have been received and placed in the file is noted.

Information Disclosure Statement

The indication that the art cited on an Information Disclosure Statement has been considered is noted.

Objection to the Drawings

On page 2 in the first paragraph and the fourth paragraph, the drawings were objected to. These objections should be considered overcome based on the proposed Drawing Correction submitted herewith. Upon approval of the drawing corrections, the Applicants will submit the corrected drawings in the time period set.

That is, in Figure 7(a) - 7(c) element 103c is shown.

Additionally, the drawings were objected to because there was an assertion that there was no description of 103c in the specification. But in the specification, for example, page 2, line 12, there is a description of 103c as well in other parts of the specification (page 2, line 7).

Attached to this Reply is a Letter for correcting the drawings as indicated in the prints of Figure 1(a), 1(b), 4(a), 4(b), 5, 6, 7(a), 7(b) and 7(c) as requested.

Upon approval of these corrections, the drawings will be corrected in the time period required.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the objection to the drawings.

Objections to the Specification

In the objection to the specification on page 3 of the Office Action, it was indicated that the Abstract should be rewritten. The Abstract has been rewritten.

It is submitted that the Abstract does comply with 37 C.F.R. 1.72. Of course, if the Examiner prefers upon allowance of this application, the Abstract may be amended by the Examiner with the opportunity of the Applicants to review the amendment.

The disclosure was objected to also because on lines 10 and 13 of page 8 "B1-B1" should be changed to --6-6-- to agree with the drawing changes. The disclosure has been amended as requested.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the objection to the disclosure.

Reply to Rejections Under 35 U.S.C. §112

Claims 1-15 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention. This rejection, in view of the amendments to the claims is traverse.

On page 4, in the second full paragraph, the points that were of concern regarding the wording of the claims have been corrected. Also, while certain claims were identified, all the claims have been reviewed and the editorial changes requested have also been made in all the claims affected in the grouping of claims 1-15.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 112.

Reply to two Rejections Under 35 U.S.C. §102

(1.) Claims 1 and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by Keys (U.S. Patent No. 5,217,786). This rejection is traversed.

In describing Keys, the Patent Office identifies element 16 as a bottom face portion, but element 16 in Figure 7 is identified as a core member. Also, in the rejection, it is stated "the pair of lip portions have lengths individually set so that, even if the door glass vibrates in the door glass run body, the lip portions may not be spaced away from the door glass".

But this is not shown in the reference, either specifically or inherently. As this is a rejection under 35 U.S.C. § 102, it is incumbent on the Examiner to particularly point out where these features and functions exist in the art. See *Ex parte Levy* 17 USPQ 2nd 1461 (BPAI 1990) wherein the Board of Appeals stated as follows:

"Moreover, it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."

It is submitted that the rejection has failed to comply with *Ex parte* Levy which is also listed in the MPEP, in the list of decisions.

Additionally, it may be that the Examiner is asserting that the features claimed may be inherent in the reference. But it is not proper to rely on inherency which is based on probability or possibility in a rejection under 35 U.S.C. § 102. See, for example, *Continental Canco. USA, Inc. B Monsanto* 20 USPQ, 2nd 1746, 1749, 1750 (Fed.Cir. 1991)(also cited in the MPEP list of decisions) wherein the Court stated as follows:

"Inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient..."

With respect to claim 6, as this claim is dependent on claim 1, it is considered patentable at least for the same reasons as base claim 1.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 102.

(2.) Claims 2-5 and 7-10 were rejected as being anticipated by Keys under 35 U.S.C. § 102. This rejection is traversed.

Here again, the Patent Office may be relying of inherency and for the reasons set forth in the second reply and the cases cited therein, this at best is a possibility or probability which is not a valid reason for rejecting the claims under 35 U.S.C. § 102.

In Keys, protrusion 29 is provided on an inner wall face of the door glass run body in an opposing relationship to a rear of at least one of the lip portions 28.

However, based on drawings on skilled in the art would consider that protrusion 29 contacts with the lip 28 on a wide face, therefore a big rattle noise might happen in said contacting. Claim 2 has been amended to avoid any inferential reading on Keys also there is no suggestion in Keys to modify structure specifically, considering the unexpected result of suppressing glass noise due to rattling.

With respect to dependent claims 3-5 and 7-10, these claims as they depend on claim 2, either directly or through intervening claims, are considered patentable at least for the same reasons as claim 2.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 102.

Reply to the two Rejections under 35 U.S.C. §103

(1.) Claim 11 was rejected under 35 U.S.C. § 103 as being unpatentable over Keys as applied to claims 1 and 6, above. This rejection is traversed.

Correctly recognizing that Keys is silent concerning the particular depth of the notch portion, the Office Action states that this is really an obvious matter of engineering design.

Initially, claim 11 distinguishes over Keys even based on the rejection under 35 U.S.C. § 103 for the reasons advanced above. Furthermore, the

particular range claimed as to the depth of the notch, that is with the range claimed, "the contact area when the lip portion is deflected and brought into contact with the inner wall face of the door glass front body can be reduced, and door glass raveling noise can be reduced". See page 7, lines 1-7 of the present specification. To consider this a "design feature" is not valid because the function of the protrusion as claimed is totally different than the function in the prior art. See *in re Chu* 36 USPQ 2nd 1089, 1095 (Fed.Cir. September 1995) (also cited in the MPEP in the list of decisions) wherein the Courts stated:

"Finding of "obviousness design choice" precluded where the claim structure and the function it performs are different from the prior art".

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

Fifth Rejection

Claims 12-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Keys as applied to claims 2-5 and 7-10, above. This rejection is traversed.

The reasons advanced for the rejection as basically the same as set forth in the rejection of claim 11. The comments in the Reply to rejection of claim 11 is also applicable here and is incorporated herein by reference. Note again, the case of *In re Chu* cited in the reply to the rejection under 35 U.S.C. § 103, of claim 11.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

New Claims

New claims 16-22 have been added. With respect to claim 16, this is an independent claim and is considered patentable over the references applied because there is no disclosure or suggestion in the combination of the references for the structure claimed in claim 16.

With respect to claim 17-22, as these are dependent claims, they are considered patentable at least for the same reasons as the claims from which they depend.

Additional Art Cited

Additional art was cited, but as this art has not been applied, no comments are considered necessary.

Conclusion

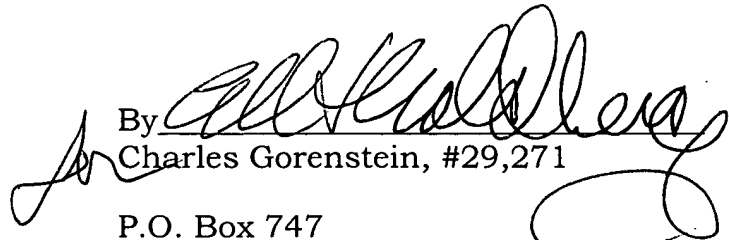
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #32,347
Charles Gorenstein, #29,271

CG/EAG/kdb/sjl
1602-0173P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment: Version with Markings to Show Changes Made

(Rev. 02/20/02)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE ABSTRACT OF THE DISCLOSURE:

The Abstract of the Disclosure has been amended as shown on the last page of this response:

IN THE SPECIFICATION:

The paragraph beginning on page 8, line 9, has been amended as follows:

FIG. 6 is a schematic sectional view taken along line [B1-B1] 6-6 of FIG. 5 showing a configuration of a conventional door glass run; and

The paragraph beginning on page 8, line 12, has been amended as follows:

FIGS. 7(a) to 7(c) are sectional views taken along line [B1-B1] 6-6 of FIG. 5 illustrating different states of the door glass run when the door glass vibrates.

IN THE CLAIMS:

The claims have been amended as follows:

1. (Amended) A door glass run attached to a door sash of a vehicle for sealing between said door sash and a door glass, comprising:
a door glass run body having a substantially U-shaped cross section; and
a pair of lip portions with each lip portion extending from opposite sides of an opening edge of said door glass run body toward a bottom face portion of said door glass run body and slidably contacting with said door glass;

said pair of lip portions having lengths individually set so that, even if said door glass vibrates in said door glass run body, said lip portions may not be spaced away from said door glass.

2. (Amended) A door glass run attached to a door sash of a vehicle for sealing between said door sash and a door glass, comprising:

a door glass run body having a substantially U-shaped cross section; and
a pair of lip portions with each lip portion extending from opposite sides of an opening edge of said door glass run body toward a bottom face portion of said door glass run body and slidably contacting with said door glass;

a protrusion being provided on an inner wall face of said door glass run body in an opposing relationship to a rear face of at least one of said lip portions and point contacting with said at least one of said lip portions;

said protrusion having a height set so that, even if said door glass vibrates, an end portion of said at least one of the lip portions [may] does not contact with [the inner face wall of] said door glass run body.

3. (Amended) The door glass run as claimed in claim 2, wherein said protrusion is disposed at a position nearer to a base end portion of the lip portion [than] compared to a position at which the lip portion and said door glass contact with each other.

6. (Amended) The door glass run as claimed in claim 1, wherein a concave notch portion is formed [in a concave with respect to] and defined by said inner wall face between a base end portion of the lip portion and said inner wall

face of said door glass run body and the concave notch portion has a depth set equal to or smaller than a predetermined depth.

7. (Amended) The door glass run as claimed in claim 2, wherein a concave notch portion is formed [in a concave with respect to] and defined by said inner wall face between a base end portion of the lip portion and said inner wall face of said door glass run body and the concave notch portion has a depth set equal to or smaller than a predetermined depth.

8. (Amended) The door glass run as claimed in claim 3, wherein a concave notch portion is formed [in a concave with respect to] and defined by said inner wall face between a base end portion of the lip portion and said inner wall face of said door glass run body and the concave notch portion has a depth set equal to or smaller than a predetermined depth.

9. (Amended) The door glass run as claimed in claim 4, wherein a concave notch portion is formed [in a concave with respect to] and defined by said inner wall face between a base end portion of the lip portion and said inner wall face of said door glass run body and the concave notch portion has a depth set equal to or smaller than a predetermined depth.

10. (Amended) The door glass run as claimed in claim 5, wherein a concave notch portion is formed [in a concave with respect to] and defined by said inner wall face between a base end portion of the lip portion and said inner wall

face of said door glass run body and the concave notch portion has a depth set equal to or smaller than a predetermined depth.

Claims 16-22 have been added.